UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,861	06/28/2006	Robert Skog	3995-50	7820

23117 7590 11/26/2008

NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

EXAMINER	
CATTUNGAL, AJAY P	
ART UNIT	PAPER NUMBER
4173	
MAIL DATE	DELIVERY MODE
11/26/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/584,861	SKOG ET AL.	
	Examiner	Art Unit	
	AJAY P. CATTUNGAL	4173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on *28 June 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *06/28/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Regarding claim 13, limitation of "a system in accordance to claim 8" is confusing. This claim is a system claim and claim 8 is a method claim.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 8, 16, 17, 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Jennings et al. (US 6,430,174).

Re claim 1, Jennings et al. discloses a method for automatically discovering the common Multimedia Service Capability of at least two user terminals when a voice call is initiated over a circuit switched network from a first one of the user terminals handled by a calling party to the second one of the user terminals that is handled by a called party, the first user terminal is capable of running simultaneously both a standard circuit voice call in a circuit switched network and a Shared Multimedia service (SMM) session supported by packet switched network, the other user terminal which user terminals Multimedia Capability may be unknown for a user of the first user terminal, the method is comprising the following steps of:

-notifying a network storage(cross reference table), by sending a capability request (determine whether multimedia enabled device) concerning the user terminals (end point device) of the calling party (callers end point device) and called party (multimedia enabled device is identified for delivery) when a trigger indication upon receipt of a call) has been generated by the circuit switched network (see Fig 2b);

- analyzing (determine) the response comprising the requested Multimedia Service Capabilities;

-responding (determine) to said user terminals information regarding matching Multimedia Capabilities, if at least one matching service is found;

said steps are performed prior to the packet switched session is established (Column 11 lines 15 to 40 and lines 52 to 58).

Re claim 8, Jennings et al. discloses that the trigger indication is generated by the use of IN technology or Parlay technology (Fig1 element 100 IN network which has trigger generation capabilities).

Re claim 9, Jennings et al. discloses a system for automatically discovering the common Multimedia Service Capability of at least two user terminals when a voice call is initiated over a circuit switched network from a first one of the user terminals to the second one of the user terminals the first user terminal is capable of running simultaneously both a standard circuit voice call in a circuit switched network and a packet switched session supported by a packet switched network, the other user terminal which user terminals Multimedia Capability may be unknown for a user of the first user terminal, wherein the system comprises means for

notifying a network storage(cross reference table), by sending a capability request concerning the user terminals (end point device) of the calling party (callers end point device) and called party (multimedia enabled device is identified for delivery), when a trigger indication (upon receipt of a call) has been generated by means in the circuit switched network (see Fig 2b), means for analyzing (determine) the response comprising the requested Multimedia Service Capabilities and means for responding (determine) to said user terminals information regarding matching Multimedia Capability, if at least one matching service is found (Column 11 lines 15 to 40, and lines 52 to 58).

Re claim 16, Jennings et al. discloses that the trigger indication generated by use of means in the circuit switched network is made by use of IN technology or Parlay technology (Fig1 element 100 IN network which has trigger generation capabilities).

Re claim 17, Jennings et al. discloses computer program product comprising computer executable software (program instruction) stored on a computer readable medium (CD ROM, disk drive), the software being adapted to run at a computer or other processing means, and wherein said computer executable software is loaded and read by said computer or other processing means (switch, server), said computer or other processing means is able to perform the steps of the method according to claim 1 (column 10, line 64 – 11, line 10).

Re claim 18, Jennings et al. discloses a server provided in a node of a system for automatically discovering the common Multimedia Service Capability of at least two

user terminals when a voice call is initiated over a circuit switched network from a first one of the user terminals to the second one of the user terminals the first user terminal is capable of running simultaneously both a standard circuit voice call in a circuit switched network and a packet switched session supported by a packet switched network, the other user terminal which user terminals Multimedia Capability may be unknown for a user of the first user terminal, wherein the server comprises means for notifying the network storage (cross reference table), by sending a capability request concerning the user terminals (end point device) of the calling party (callers end point device) and the called party (multimedia enabled device is identified for delivery), when a trigger indication (upon receipt of a call) has been generated by the circuit switched network (see Fig 2b), means for analyzing (determine) the response comprising the requested Multimedia Service Capability and means for responding (determine) to said user terminals information regarding matching Multimedia Capability, if at least one matching service is found (Column 11 lines 15 to 40, and lines 52 to 58).

Re claim 24, Jennings et al. discloses that the trigger indication generated by use of means in the circuit switched network is made by use of IN technology or Parlay technology (Fig1 element 100 IN network which has trigger generation capabilities).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 2, 10, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jennings et al. (US 6,430,174) in view of Lee et al. (US 6,751,459).

Re Claim 2, Jennings et al. discloses the claimed invention as set forth in claim 1 above. Jennings et al. does not explicitly disclose the network storage that comprises a Terminal Capability database (TCdb). However, Lee et al. teaches of a network storage that comprises a Terminal Capability database (TCdb) (column 17 lines 19- 23). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the terminal capability database of Lee et al. with the system of Jennings et al. in order to deal with the unpredictability of user behavior and enable multimedia services to be simultaneously matched to an incoming session.

Re claim 10, Jennings et al. discloses the claimed invention as set forth in claim 9 above. Jennings et al. does not explicitly disclose wherein the network storage comprises a Terminal Capability database (TCdb). However, Lee et al. teaches that network storage comprises a Terminal Capability database (TCdb) (column 17 lines 19-

23). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the terminal capability database of Lee et al. with the system of Jennings et al. in order to deal with the unpredictability of user behavior and enable multimedia services to be simultaneously matched to an incoming session.

Re claim 19, Jennings et al. discloses the claimed invention as set forth in claim 18 above. Jennings et al. does not explicitly disclose the network storage comprises a Terminal Capability database (TCdb). However, Lee et al. teaches network storage that comprises a Terminal Capability database (TCdb) (column 17 lines 19- 23). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the terminal capability database of Lee et al. with the system of Jennings et al. in order to deal with the unpredictability of user behavior and enable multimedia services to be simultaneously matched to an incoming session.

7. Claims 3, 11, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jennings et al. (US 6,430,174) in view of Aholainen et al. (US 7,280,832).

Re Claim 3, Jennings et al. discloses the claimed invention as set forth in claim 1 above. Jennings et al. does not explicitly disclose wherein the network storage also comprises a Bearer database (Bdb). However, Aholainen et al. teaches that the network storage also comprises a Bearer database (Bdb) (column 6 lines 24-29). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the Bearer database of Aholainen et al. with the system of Jennings et al.

in order to get information about user terminals for providing a connection between them wirelessly.

Re Claim 11, Jennings et al. discloses the claimed invention as set forth in claim 9 above. Jennings et al. does not explicitly disclose wherein the network storage also comprises a Bearer database (Bdb). However, Aholainen et al. teaches that the network storage also comprises a Bearer database (Bdb) (column 6 lines 24-29). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the Bearer database of Aholainen et al. with the system of Jennings et al. in order to get information about user terminals for providing a connection between them wirelessly.

Re Claim 20, Jennings et al. discloses the claimed invention as set forth in claim 18 above. Jennings et al. does not explicitly disclose wherein the network storage also comprises a Bearer database (Bdb). However, Aholainen et al. teaches that the network storage also comprises a Bearer database (Bdb) (column 6 lines 24-29). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the Bearer database of Aholainen et al. with the system of Jennings et al. in order to get information about user terminals for providing a connection between them wirelessly.

8. Claims 4, 12, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jennings et al. (US 6,430,174) in view of Zhang et al. (US 6,661,785).

Re Claim 4, Jennings et al. discloses the claimed invention as set forth in claim 1

above with the step of notifying the network storage (cross reference table) by sending a capability request concerning the user terminals (end point device) of the calling party (callers end point device) and called party (multimedia enabled device is identified for delivery). Jennings et al. does not explicitly disclose the sending of a capability request is initiated upon a trigger event based on either Set-up_notification or Answer notification. However, Zhang et al. teaches the sending a capability request (query) is initiated upon a trigger event (trigger event notification) based on either Set-up_notification or Answer notification (Column 4 lines 55-61, Column 5 lines 24 -30 Here the SSP send the trigger notification either on setup notification or on answer notification). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the trigger event notification of Zhang et al. with the system of Jennings et al. in order to trigger a code upon receiving a call.

Re Claim 12, Jennings et al. discloses the claimed invention as set forth in claim 9 above with the means of notifying the network storage (cross reference table) by sending a capability request concerning the user terminals (end point device) of the calling party (callers end point device) and called party (multimedia enabled device is identified for delivery). Jennings et al. does not explicitly disclose the sending of a capability request starts when it receives an indication that a trigger event based on either Set-up_notification or Answer notification has occurred. However, Zhang et al. teaches the sending a capability request (query) starts when it receives an indication that a trigger event (trigger event notification) based on either Set-up_notification or Answer notification has occurred (Column 4 lines 55-61, Column 5 lines 24 -30 Here the

SSP send the trigger notification either on setup notification or on answer notification). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the trigger event notification of Zhang et al. with the system of Jennings et al. in order to trigger a code upon receiving a call.

Re Claim 21, Jennings et al. discloses the claimed invention as set forth in claim 18 above with the means of notifying the network storage (cross reference table) by sending a capability request concerning the user terminals (end point device) of the calling party (callers end point device) and called party (multimedia enabled device is identified for delivery). Jennings et al. does not explicitly disclose the sending of a capability request starts when it receives an indication that a trigger event based on either Set-up_notification or Answer notification has occurred. However, Zhang et al. teaches the sending a capability request (query) starts when it receives an indication that a trigger event (trigger event notification) based on either Set-up_notification or Answer notification has occurred (Column 4 lines 55-61, Column 5 lines 24 -30 Here the SSP send the trigger notification either on setup notification or on answer notification). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the trigger event notification of Zhang et al. with the system of Jennings et al. in order to trigger a code upon receiving a call.

9. Claims 5, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jennings et al. (US 6,430,174) in view of Basilier et al. (US 2003/0233457).

Re Claim 5, Jennings et al. discloses the claimed invention as set forth in claim 1 above with the steps of notifying the network storage by sending a capability request

concerning the user terminals of the calling party and called party, analyzing the response comprising the requested Multimedia Service Capability and responding to said user terminals information regarding matching Multimedia Capabilities, if at least one matching service is found (system determines that multimedia communications are enabled). Jennings et al. does not explicitly disclose the steps of notifying are performed by an Application Server for Shared Multimedia, SMM_AS. However Basilier et al. teaches the steps of notifying are performed by an Application Server (application server) for Shared Multimedia, SMM_AS (paragraph 23 line 7). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the application server of Basilier et al. with the system of Jennings et al. in order to provide multimedia service to mobile terminal.

Re Claim 13, Jennings et al. discloses the claimed invention as set forth in claim 9 above with the means for notifying the network storage by sending a capability request concerning the user terminals of the calling party and called party, means for analyzing the response comprising the requested Multimedia Service Capabilities and means for responding to said user terminals information regarding matching Multimedia Capability, if at least one matching service is found (system determines that multimedia communications are enabled). Jennings et al. does not explicitly disclose the means for notifying are provided in an Application Server for Shared Multimedia, SMM-AS. However Basilier et al. teaches the means for notifying are provided in an Application Server for Shared Multimedia, SMM-AS (paragraph 23 line 7). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to

use the application server of Basilier et al. with the system of Jennings et al. in order to provide multimedia service to mobile terminal.

10. Claims 6,7,14, 15, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jennings et al. (US 6,430,174) in view of Vaananan et al. (US 7,369,864).

Re Claim 6, Jennings et al. discloses the claimed invention as set forth in claim 1 above and disclose the step of responding to said user terminals (end point device) information regarding matching Multimedia Capabilities for alerting the user (deliver a multimedia interface) of the possibility to start a Multimedia service session (multimedia communications). Jennings et al. does not explicitly disclose that the step of responding to said user terminals is performed by transmitting to each of said user terminals one message, preferably a WAP_Push message. However, Vaananan et al. teaches that the step of responding to said user terminals is performed by transmitting to each of said user terminals (terminal) one message, preferably a WAP_Push message (WAPPush message) (column 5 lines 13-16). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the WAP_Push message method used by Vaananan et al. with the system of Jennings et al. in order to alert the user terminals about the options it has.

Re Claim 7, Jennings et al. discloses the claimed invention as set forth in claim 1 above. Jennings et al. does not explicitly disclose that the user terminals will not start a packet switched session until said message has been received by the two user terminals. However, Vaananan et al. teaches that the user terminals will not start a

packet switched session (preceding the actual message) until said message (initialisation message) has been received by the two user terminals (terminal) (column 5 lines 19-24). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the packet switched session method used by Vaananan et al. with the system of Jennings et al. in order to alert the user terminals about the options it has.

Re Claim 14, Jennings et al. discloses the claimed invention as set forth in claim 9 above and disclose the means for responding to said user terminals (end point device) information regarding matching Multimedia Capabilities for alerting the user (deliver a multimedia interface) of the possibility to start a Multimedia service session (multimedia communications). Jennings et al. does not explicitly disclose that the step of responding to said user terminals is performed by transmitting to each of said user terminals one message, preferably a WAP_Push message. However, Vaananan et al. teaches that the step of responding to said user terminals is performed by transmitting to each of said user terminals (terminal) one message, preferably a WAP_Push message (WAPPush message) (column 5 lines 13-16). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the WAP_Push message method used by Vaananan et al. with the system of Jennings et al. in order to alert the user terminals about the options it has.

Re Claim 15, Jennings et al. discloses the claimed invention as set forth in claim 9 above. Jennings et al. does not explicitly disclose that the user terminals will not start a packet switched session until said message has been received by the two user

terminals. However, Vaananan et al. teaches that the user terminals will not start a packet switched session (preceding the actual message) until said message (initialisation message) has been received by the two user terminals (terminal) (column 5 lines 19-24). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the packet switched session method used by Vaananan et al. with the system of Jennings et al. in order to alert the user terminals about the options it has.

Re Claim 22, Jennings et al. discloses the claimed invention as set forth in claim 18 above and disclose the means for responding to said user terminals (end point device) information regarding matching Multimedia Capabilities for alerting the user (deliver a multimedia interface) of the possibility to start a Multimedia service session (multimedia communications). Jennings et al. does not explicitly disclose that the step of responding to said user terminals is performed by transmitting to each of said user terminals one message, preferably a WAP_Push message. However Vaananan et al. teaches that the step of responding to said user terminals is performed by transmitting to each of said user terminals (terminal) one message, preferably a WAP_Push message (WAPPush message) (column 5 lines 13-16). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the WAP_Push message method used by Vaananan et al. with the system of Jennings et al. in order to alert the user terminals about the options it has.

Re Claim 23, Jennings et al. discloses the claimed invention as set forth in claim 18 above. Jennings et al. does not explicitly disclose that the user terminals will not start

a packet switched session until said message has been received by the two user terminals. However, Vaananan et al. teaches that the user terminals will not start a packet switched session (preceding the actual message) until said message (initialisation message) has been received by the two user terminals (terminal) (column 5 lines 19-24). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the packet switched session method used by Vaananan et al. with the system of Jennings et al. in order to alert the user terminals about the options it has.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AJAY P. CATTUNGAL whose telephone number is (571)270-7525. The examiner can normally be reached on Monday- Friday 7:30 - 5:00, Alternating Fridays OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jinhee Lee can be reached on 571-292-1977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jinhee J Lee/

Supervisory Patent Examiner, Art Unit 4173

/A. P. C./
Examiner, Art Unit 4173